IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: **KOYANO=1**

In re Application of:	)	Conf. No.: **1954**
Hiroshi KOYANO et al	)	Art Unit: **1625**
Appln. No.: 10/584,233	)	Examiner: **T. A. SOLOLA**
Filed: December 27, 2004 371 (C): June 26, 2006	)	Washington, D.C.
For: **BENZAMIDE DERIVATIVE**	)	**December 29, 2008** **MONDAY**

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

The applicants are in receipt of the Office Action mailed October 27, 2008. Attached is a petition for one month's extension of time and payment of the petition fee.

Restriction has been required among what the PTO deems as being ten (10) separate inventions, purportedly under the provision of PCT Rules 13.1 and 13.2. As applicants must make an election even though the requirement is traversed, applicants elect as explained below, with traverse and without prejudice.

The Examiner set forth Groups I to X of inventions in the Office Action. However, applicants note that the

compounds of formula (I) recited in claim 1 wherein A_1 is C-X_1, Q_1 is-A_2=A_3-, Q_2 is -A_4=A_5-, A_2 is C-X_2, A_3 is C-X_3, A_4 is C-X_4, and A_5 is C-X_5, namely A_1-Q_1-Q_2- ring is a ring having no hetero atom e.g. a benzene ring, are not included in any of the groups. Applicants assume that this omission is due to an error made in the PTO; and, accordingly, the group of compounds that the applicants wish to elect are not included in any of Groups I to X.

Applicants instead wish to and do respectfully and provisionally elect subject matter falling within claim 1 as follows:

> A_1 is C-X_1, Q_1 is-A_2=A_3-, Q_2 is -A_4=A_5-, A_2 is C-X_2, A_3 is C-X_3, A_4 is C-X_4, and A_5 is C-X_5

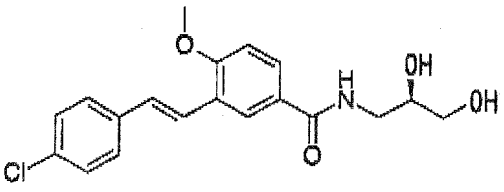
Applicants respectfully traverse the requirement among Groups I-IX because the same claims are involved in all nine groups and the above elected subject matter as well, and this is in clear violation of *In re Weber* et al, 198 USPQ 328, 331 (CCPA 1978), which applicants request the examiner to carefully read. The claims are clearly generic because they cover all of Groups I-IX and the elected subject matter, and applicants are entitled to their invention generically, i.e. the PTO cannot properly and legally force an applicant to

claim less than what the applicant perceives his or her generic invention is, if the claims are not rejected.

The restriction requirement among Groups I-IX and the elected subject matter should therefore be withdrawn on the basis of *In re Weber, supra*.

As regards Group X, applicants respectfully submit that a complete search of the elected subject matter would also require a search of the Group X, claims 13-17, in which case the situation would fall under the second paragraph of MPEP 803. Applicants therefore also request withdrawal of the requirement insofar as Group X is concerned.

The PTO has further required an election of species, and in this regard applicants hereby respectfully and provisionally elect the compound of the following formula, disclosed in example 2-2-48 of the present application:



Applicants take no position at the present time on whether various species are or are not patentably distinct from one another. However, applicants respectfully submit

that the species within the genus so elected are sufficiently similar so that they can all be examined without serious burden as required by the second paragraph of MPEP 803.

Applicants now respectfully await the results of an examination on the merits.

Respectfully submitted,

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